

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 7-11, and 17-28 are pending in the application, with claims 1 and 11 being the independent claims. New claims 21-28 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Objection to the Drawings

The Examiner has objected to the drawings under 37 CFR 1.83(a) as failing to show every feature of the invention specified in the claims. In the attached replacement formal drawings submitted herewith, Applicant has amended FIG. 4 to include reference to the claimed hook and loop fasteners. Applicant has also amended paragraph [0024] of the specification to reflect the label changes found in FIG. 4. Applicant submits that these changes represent corrections of informalities and do not include any new matter. Support for the amendment to FIG. 4 is found at least at paragraph [0024] of the application as filed. Applicant respectfully requests that the objection be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1, 9-11, 19 and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,188,450 to Coons (the "Coons patent"). The Examiner specifically points to screen shield 21 of the Coons patent.

By the present amendment, independent claim 1 has been amended to specifically recite that the claimed privacy shade comprises a material *attached to a top portion of the computer monitor by a hook and loop fastener* and independent claim 11 has been amended to specifically recite that the claimed privacy shade comprises a material *attached to a top portion of the display device by a hook and loop fastener*. The Coons patent does not disclose attachment of a privacy shade to a top portion of a computer monitor or display device by a hook and loop fastener. Col. 4, ln 25-35 discloses that screen shield 21 is secured to the top front corners of side covers 16a, 16b, which are, in turn, secured to the monitor by use of securing straps 28 and/or held in place by the addition of screen frame piece 27. For at least this reason, amended independent claims 1 and 11 and claims 7-10 and 17-28 which depend therefrom, are patentable and Applicant respectfully requests that the Examiner reconsider the rejection and that it be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 3-5, 7, 8, 13-15, 17 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Coons patent. The Examiner argues that "the manner in which the shade is fastened to the monitor by way of engaging the covers 16a, 16b, is clearly an obvious design choice. Snaps, hooks, adhesives and clips are all well known

attachment means and it would have been obvious to use these due to their inherent advantages.” Office Action at 3-4.

Claims 2, 6, 12 and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Coons patent, in view of U.S. Patent No. 5,499,793 to Salansky (“the Salansky patent”). The Examiner argues that, “Salansky discloses the use of hook and loop fasteners or adhesive, column 5, lines 5-13, for attaching computer accessories to the computer monitor. In view of this teaching, it would have been obvious to use such fasteners to attach the cover 21 of Coons to the monitor, either directly or through further attachment to covers 16a, 16b.” Office Action at 4.

Applicants traverse these rejections. As discussed above, the Coons patent does not disclose attachment of a privacy shade to a top portion of a computer monitor or display device by a hook and loop fastener, as claimed. Additionally, it would not have been obvious to one of ordinary skill in the art to combine the Salansky patent with the Coons patent as the Examiner has suggested to arrive at the claimed invention.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-73, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more evidence of unpatentability applicants are entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

Where prior art references require a selective combination to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). The mere fact that the prior art

may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

The privacy shade of the present invention comprises a shade that provides quick concealment of information displayed on a screen, such as a computer monitor or display device. Due to the easy maneuverability of the privacy shade of the present invention, the shade may be used on an as needed basis, such as is required in the medical industry, as a way to conceal private medical information from unauthorized people in seconds.

As discussed in the background section of the invention, the medical industry requires protection of health information under the Health Insurance Portability and Accountability Act of 1996 (HIPAA). HIPAA requires that physical safeguards be implemented to insure that health information is protected. The privacy shade of the present invention provides a physical safeguard as required, which also meets medical industry standards.

In order to be utilized and accepted in the medical industry, the product must be able to meet certain conditions. For example, the product must be capable of being quickly removed and replaced, such as from a monitor in a lab, hospital, or office, if blood or urine or the like is splattered on it. According to the present invention, the privacy shade can be quickly and safely removed and replaced by lifting off the shade from the *hook and loop fastener* attached to the monitor and replacing it with a clean shade. Additionally, periodic washing of the product will be necessary in a medical environment. The privacy shade of the present invention, made of *a lightweight, flexible material*, such as cotton or a cotton blend, requires no special washing instructions and can be included with a regular wash cycle that includes sheets, lab coats, etc.

Unlike the claimed invention, the cover disclosed in the Coons patent cannot be removed quickly or easily because the cover disclosed in the Coons completely encases a computer monitor, as shown in Fig. 5 of the Coons patent. For example, the Coons patent states that “the data transfer cable or signal cable which runs between monitor 11 and the computer to which it is attached [is] placed through CRT cover 10 for the connection to the monitor 11”. (col. 5, ln. 44-46). In this manner, in order to remove the cover disclosed in the Coons patent, the computer would have to be shut down so that the cables can be removed from the CRT cover. Consequently, removal of the cover disclosed in the Coons patent is difficult and cannot be accomplished quickly.

The Coons patent does not disclose attachment of screen shield 21 to a top portion of a computer monitor by a hook and loop fastener, as claimed in the present invention. In fact, due to the various sizes, contours and indentations of monitors, the use of hook and loop fasteners would not be an effective source for securing the screen shield 21 and the other elements of the framework of the CRT cover disclosed in the Coons patent. The use of hook and loop fasteners would likely not withstand the weight of holders 22 and the like, which are mounted to the framework of the CRT cover disclosed in the Coons patent for storing supplies. (*see* col. 3, ln. 44-51). In fact, it appears that Coons anticipated the ineffectiveness of hook and loop fasteners, in that the Coons patent describes other methods of securing the panels to the monitor. The Coons patent at col. 4, ln 25-35 discloses that screen shield 21 is secured to the top front corners of side covers 16a, 16b, which are, in turn, secured to the monitor by use of securing straps 28 and/or held in place by the addition of screen frame piece 27. While the Coons patent describes the use of VELCRO for holding and mounting text holders 26 or holders 22 to the framework of the CRT cover, it appears he recognized that VELCRO would

not be an effective way to attach the framework of the CRT cover, including screen shield 21, to a monitor.

The Salansky patent does not provide motivation or suggestion to ignore these teachings in the Coons patent. The Salansky patent discloses a document holder having panels for supporting standard and/or legal sized paper which are connected to a frame for attachment to a computer monitor. However, unlike the Coons patent, the Salansky patent does not disclose attaching holders for storing supplies to the framework. As such, one of ordinary skill in the art would not have been motivated by the Salansky patent to modify the framework of the CRT cover disclosed in the Coons patent as the Examiner suggests. The Examiner provides no motivation or suggestion, other than impermissible hindsight based on Applicant's disclosure, that would lead one of ordinary skill in the art to adopt features of the document holder disclosed in the Salansky patent when looking to improve upon the framework of the CRT cover disclosed in the Coons patent.

As the Federal Circuit has held numerous times, this type of hindsight analysis is impermissible -- to support a prima facie case of obviousness, the suggestion or motivation to make and use a claimed invention must come from the prior art itself, and not from the applicant's own teachings. *See In re Pleuddemann*, 910 F.2d 823, 828, 15 U.S.P.Q.2d 1738, 1742 (Fed. Cir. 1990) (noting that use of an applicant's specification as though it were prior art to support an obviousness determination is legal error); *see also In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (stating that both the suggestion and reasonable expectation of success in making a claimed composition "must be founded in the prior art, not in the applicant's disclosure"). "It is impermissible to use the claimed invention as an instruction manual or 'template' to

piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 972 F.2d at 1266, 23 U.S.P.Q.2d at 1784.

None of the cited references, alone or in combination, disclose or suggest the privacy shade of the claimed invention, comprising *a piece of lightweight, flexible material*, of a shape and size to cover the viewing area of a computer monitor or display device and provide concealment of the information displayed thereon when the material is in a down position, wherein the material is *attached to a top portion of a computer monitor or display device by a hook and loop fastener* such that said material covers the viewing area of the computer monitor or display device when the material is in the down position. For at least these reasons, amended independent claims 1 and 11 and claims 7-10 and 17-28 which depend therefrom, are patentable and Applicant respectfully requests that the Examiner reconsider the outstanding rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 112

Claims 3-5 and 13-15 have been rejected under 35 U.S.C. § 112 as failing to comply with the enablement requirement. By the above amendment, claims 3-5 and 13-15 have been canceled. As such these rejections are moot.

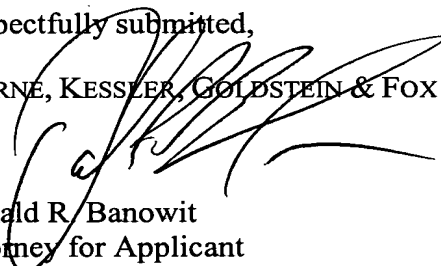
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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